

LBNL – PROCUREMENT STANDARD PRACTICES

Section: 27 Patents, Data and Copyrights

Subject: 27.1 Patents, Data and Copyrights

PURPOSE: This standard practice (SP) identifies the requirements for the use of patent, data, and copyright clauses in subcontracts.

POLICY: The Laboratory will comply with DOE regulations designed to protect DOE's rights to patents, copyrights, and technical data (also referred to as intellectual property) first produced by the Laboratory or its subcontractors.

SCOPE: This SP applies to all written solicitations and subcontracts.

Exemptions This SP does not apply to Intra-University Transactions (IUTs) or subcontracts covered by international agreements.

DEFINITIONS:

Copyright A copyright is a legal right to exclusively reproduce, distribute copies, prepare derivative works, or display or perform publicly a creative work recorded in a tangible medium with a copyright notice for a certain period of time.

Computer Software Computer software is a computer program, database, or documentation thereof.

Data Data is any recorded information, regardless of form or the media on which it may be recorded. Data includes technical data and computer software.

Limited Rights Data Limited rights data is data (other than computer software) developed at private expense that embodies trade secrets or is commercial or financial and confidential or privileged.

Patent A patent is a grant made by the Government to an invention, assuring the sole right to make, use, and sell the invention for a certain period of time.

Restricted Computer Software Restricted computer software is any computer program, computer database, or documentation thereof, that has been developed at private expense and either is a trade secret, is commercial or financial and confidential or privileged, or is published and copyrighted. It includes minor modifications of such software.

PROCEDURES:

Solicitations and Subcontracts Intellectual property clauses identified by DOE and the University (see Clauses) will be included in Laboratory written solicitations and subcontracts.

Patent Clearance For subcontracts containing a Patent Rights clause, a patent clearance must be obtained before final payment may be issued. Request a patent certification from the subcontractor and forward the certification to Laboratory Council–Intellectual Property for clearance. (See SP 42.4, Subcontract Closeout.)

Software License Agreements When a software license agreement is part of a subcontract, the procurement specialist should furnish the requester with a copy of the negotiated, executed license agreement and any

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modifications to the agreements.

A copy of the cover memo, transmitting the agreement to the requester, should be made a part of the subcontract file. The cover memo will advise the requester that users of the software should become familiar with the agreement terms and conditions, limitations, and restrictions for use.

RESPONSIBILITIES:

Procurement Specialist

The procurement specialist will:

- Determine which clauses to include in solicitations and subcontracts;
- Obtain guidance from Laboratory Counsel on intellectual property-related matters;
- Obtain a patent clearance for subcontracts containing a Patent Rights clause; and
- Furnish a copy of software license agreements to requesters.

CLAUSES:

Include the intellectual property clauses shown in Exhibit 27.1.a in solicitations and subcontracts.

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Exhibit: 27.1.a Patent and Data Clause Matrix

USE OF PATENT AND DATA CLAUSES IN CONTRACTING

Regulation	Patent & Data Clauses	R, D, or D Type (SEE S.O.W.) Fixed Price, CPFF, Cost Reimbursed, etc. POs or contracts.				Non R, D, or D Type Fixed Price, CPFF, Cost Reimbursed POs or contracts for Standard ("off shelf") supplies or services.		
		Small Bus.	Non Profit	Consultant	All Others Including A&E	Construction	Supplies	Time & Materials
	Authorization & Consent (A&C)							
48 CFR 52.227-1	Narrow A&C				X	X	X	X
48 CFR 52.227-1 (Alt 1)	Broad A&C	X	X	X	X (1)	X (1)		
	Patent Indemnity (2)							
48 CFR 52.227-4	Construction					X		
48 CFR 52.227-3	All contracts where commercial supplies are furnished						X	X
48 CFR 52.227-2	Notice & Assistance Re. P&C	X	X	X	X	X	X	X
48 CFR 52.227-6	Royalty Information (In Proposal Requests, except sealed bids)							
48 CFR 52.227-9 [3/95]	Refund of Royalties (3)	X	X	X	X	X	X	X
48 CFR 927.303	Patent Rights (11) (12)							
48 CFR 952.227-13 [3/95]	Acquisition by Government (4)			X	X			
48 CFR 952.227-11 [3/95]	Retention by Contractor (5)	X	X	X				
48 CFR 927.4	Rights in Technical Data							
48 CFR 52.227-14 + (7)	Rights in Data - General (8) (9)	X	X	X	X	X	X	X
48 CFR 52.227-16	Additional Tech Data Requirements	X	X (6)		X	X	X (For nonstandard data)	
48 CFR 52.227-23	Rights to Proposal Data	Insert in all contracts where there is proposal data						
48 CFR 52.215-12	Restriction on Disclosure & Use of Data	Insert in all RFPs and RFQs where the offeror may submit proposal data that is asserted to be proprietary						
48 CFR 9-9.106	Classified Invention	Insert in all contracts likely to cover classified subject matter						
48 CFR 52.227-15	Representation of Limited Rights Data & Restricted Computer Software	Use in solicitations per 48 CFR 27.409(g), as well as other appropriate clauses (10)						
1 Construction and architect-engineer contracts require treatment as R, D or D where the contractor is performing design, testing or first actual reduction to practice of apparatus or equipment, or is tasked to perform demonstration. See 48 CFR 27.304-3.		7 This clause is 52.227-14 + Alternates I and V + paragraph (d)(3). Para (d)(3) is found in AL 87-5; FAL 87-2.						
2 For non R,D & D work, or when both performance and delivery occur outside the U.S. or where DOE or GOCO determines that standard commercial items or processes will be involved in contract or subcontract work, a patent indemnity clause should be inserted in prime contract.		8 Alternate II: If delivery of limited right data to Government is required add paragraph (g)(2).						
3 Use in solicitations and contracts where royalties may be paid by the contractor or subcontractor of any tier per 48 CFR 927.206-2.		9 Alternate III: If delivery of restricted computer software is required, add paragraph (g)(3).						
4 Use in solicitations and contracts provided the performing contractor or subcontractor is other than a small business or nonprofit organization.		10 52.227-17 Rights in Data - Special Works 52.227-18 Rights to Existing Works 52.227-19 Commercial Computer Software - Restricted Rights 52.227-20 Rights to Data in Small Business Innovation Research (SBIR) 952.227-75 Alt II Contractor Licensing of Limited Rights Data & Restricted Computer Software (Mod) - applies to large businesses						
5 Other than M&O contractors. If it is believed that "exceptional circumstances" under 35 USC 200 et seq. exist, where it is not appropriate for the small business or nonprofit to retain title in inventions, consult DOE Patent Counsel for revisions.		11 For M&O contracts, see 48 CFR 970.5204-71 or 72.						
6 Do not use with college or university for R, D or D contracts below \$500,000.		12 For advance waiver use 48 CFR 52.227-12 supplied by Patent Counsel.						